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MAILED

AUG 18 2010

OFFICE OF PETITIONS

In re Application of	:	
Bunger et al.	:	DECISION ON APPLICATION
Application No. 09/822,961	:	FOR PATENT TERM ADJUSTMENT
Filed: March 30, 2001	:	
Attorney Docket No. 134779.13101	:	

This is in response to the "Request for Reconsideration of Patent Term Adjustment Pursuant to 37 CFR §1.705(b)" filed February 17, 2010. Applicants request the initial determination of patent term adjustment be corrected from zero (0) days to nine hundred fifty-two (952) days.

The application for patent term adjustment is **granted to the extent indicated herein.**

When calculating the initial patent term adjustment, the Office determined the total amount of Office delay under 37 C.F.R. § 1.703(a) ("A Delay") was 707 days and the total amount of delay under 37 C.F.R. § 1.704 ("Applicant Delay") was 873 days. The number of days of A Delay reduced by the number of days of Applicant Delay is -166 days. The Office does not set forth negative balances of patent term adjustment. Therefore, the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed November 17, 2009, advised Applicants of a patent term adjustment to date of 0 days. In response, Applicants timely filed this application for patent term adjustment with payment of the issue fee on February 17, 2010.

As will be discussed, the Office has determined the total amount of Applicant Delay as of the mailing date of the Notice of Allowance is 797 days, not 873 days. In other words, the number of days of A Delay reduced by the number of days of Applicant Delay is -90 days. The Office has updated the PALM screen to reflect the number of days of A Delay reduced by the number of days of Applicant Delay is -90 days. A copy of the updated PALM screen is enclosed.

Since the initial patent term adjustment remains a negative balance, the updated PALM screen correctly states the patent term adjustment as of the date of the mailing of the Notice of Allowance is 0 days.

Although the instant decision does not result in a change to the *initial* patent term adjustment, the Office notes the total Office delay as of the date the patent issues will include delay under 37

C.F.R. § 1.702(a)(4) and 37 C.F.R. § 1.703(b). In other words, as of the date the patent issues, the total amount of Office delay may well be greater than the total amount of Applicant Delay.

Summary of Applicants' Arguments

Applicants assert the patent term adjustment should be 952 days based on the following arguments:

1. The patent term adjustment should include an increase of 939 days for delay under 37 C.F.R. § 1.703(b) ("B Delay");
2. The patent term adjustment should include a 88-day reduction, instead of a 143-day reduction, for Applicant Delay resulting from the filing of a response to a restriction requirement on July 8, 2005; and
3. The patent term adjustment should include a reduction of 42 days for Applicant Delay resulting from the filing of an information disclosure statement ("IDS") on November 12, 2007.

B Delay

To the extent Applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. *See* 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination ("RCE") was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with

the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

Applicant Delay Involving the Response Filed July 8, 2005

The Office mailed a restriction requirement on January 11, 2005. The Office received a reply to the restriction requirement on February 15, 2005. On June 2, 2005, the Office mailed a notice informing Applicants the February 15, 2005 reply was non-responsive. Pursuant to 37 C.F.R. § 1.135(c), the notice provided Applicants with a new time period to file a proper response to the restriction requirement. A "Response to Notice of Non-Compliant Amendment" was filed July 8, 2005.

The Office entered a reduction of 143 days for Applicant Delay as a result of the July 8, 2005 response. Applicants argue the Office should have entered a reduction of 88 days instead of 143 days.

The "Response to Notice of Non-Compliant Amendment" was filed July 8, 2005, three months and 88 days after the Office mailed the restriction requirement. Therefore, Applicants assertion the correct amount of Applicant Delay is 88 days appears to be based on a belief the Office entered the 143-day reduction under 37 C.F.R. § 1.704(b). However, the 143-day reduction was entered under 37 C.F.R. § 1.704(c)(7).

Pursuant to 37 C.F.R. § 1.704(c)(7), circumstances that will result in a reduction in the period of adjustment include:

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In this case, a reply with an omission was filed February 15, 2005. The number of days beginning on February 16, 2005, the day after the date the reply having an omission was filed, and ending on July 8, 2005, the date the reply correcting the omission was filed, is 143 days. Therefore, the Office appropriately entered a 143-day reduction under 37 C.F.R. § 1.704(c)(7).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 C.F.R. § 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 C.F.R. § 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 C.F.R. § 1.705(b) and 35 U.S.C. § 154(b)(3)(B). A dispute as to the calculation of the 37 C.F.R. § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) will be dismissed as untimely filed.

Applicant Delay Involving the November 12, 2007 IDS

The Office mailed a Final Office action on June 29, 2007. A Request for Continued Examination ("RCE") and an amendment were filed October 1, 2007. An IDS was subsequently filed November 12, 2007.

Applicants assert the Office should have entered a reduction of 42 days as a result of Applicants filing the November 12, 2007 IDS.

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The record fails to indicate the November 12, 2007 IDS was expressly requested by the examiner and the IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d). The number of days beginning October 2, 2007, the day after the date of the submission of the first reply, and ending on November 12, 2007, the date the IDS was filed, is 42 days.

In view of the prior discussion, the Office agrees a reduction of 42 days should have been entered under 37 C.F.R. § 1.704(c)(8) as a result of the IDS filed November 12, 2007.

Applicant Delay Involving a "Notice of Related Cases" Filed November 15, 2007

A review of the record indicates a 3-day reduction should have been entered as a result of the "Notice of Related Cases" filed November 15, 2007.

The Office mailed a Final Office action on June 29, 2007. A Request for Continued Examination ("RCE") and an amendment were filed October 1, 2007. An IDS was filed November 12, 2007, and a Notice of Related Cases ("Notice") was filed November 15, 2007.

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The record fails to indicate the Notice filed November 15, 2007, was expressly requested by the examiner. Therefore, the filing of the Notice should have resulted in a reduction under 37 C.F.R. § 1.704(c)(8).

The number of days beginning October 2, 2007, the day after the date of the submission of the first reply, and ending on November 15, 2007, the date the Notice was filed, is 45 days. However, 42 of the 45 days of delay overlap with the 42 days of Applicant Delay entered as a result of the November 12, 2007 IDS. Therefore, the number of days of reduction that should have been entered under 37 C.F.R. § 1.704(c)(8) as a result of the November 15, 2007 Notice is 3 days.

Applicant Delay on or Before August 9, 2002

The Office mailed a Notice to File Missing Parts of Nonprovisional Application on May 8, 2001, requiring the submission of an executed oath or declaration.

A reply to the notice was filed January 3, 2002. The reply consisted of a petition under 37 C.F.R. § 1.47(a). The reply did not include an oath or declaration.

A second reply to the notice was filed January 8, 2002. The second reply included a petition under 37 C.F.R. § 1.47(a) and a declaration signed by six of the seven inventors.

On January 30, 2002, the Office mailed a decision addressing the January 3, 2002 petition, as supplemented by the papers filed January 8, 2002. The decision dismissed the petition and set a two-month time period for Applicants to respond to the decision in order to avoid abandonment of the application.

A declaration signed by all of the inventors was filed July 31, 2002. On August 9, 2002, the Office mailed a decision dismissing the request for status under 37 C.F.R. § 1.47(a) as moot.

Based on the events identified above, the Office entered a reduction in patent term adjustment of 366 days, which is the number of days beginning August 9, 2001, the day after the date three months after the Office mailed the Notice to File Missing Parts, and ending August 9, 2002, the date the Office mailed a decision dismissing the request for status under 37 C.F.R. § 1.47(a) as moot.

Although Applicants have not objected to the entry of the 366-day reduction, the Office has reviewed the record and determined the Office should not have entered a 366-day reduction under 37 C.F.R. § 1.704(b). Instead, as will be discussed, the Office should have entered a reduction of 153 days and a reduction of 92 days under 37 C.F.R. § 1.704(b).

Applicants filed a sufficient reply to the May 8, 2001 Notice to File Missing Parts on January 8, 2002, which is 3 months and 153 days after the Office mailed the notice. Therefore, a reduction of 153 days is warranted under 37 C.F.R. § 1.704(b).

Applicants filed a proper reply to the January 30, 2002 decision on July 31, 2002, which is 3 months and 92 days after the Office mailed the decision. Therefore, a reduction of 92 days is warranted under 37 C.F.R. § 1.704(b).

In view of the prior discussion, the Office should have entered a 153-day reduction and a 92-day reduction under 37 C.F.R. § 1.704(b), instead of a 366-day reduction, for Applicant Delay accrued on or before August 9, 2002.

Conclusion

As previously discussed in the instant decision,

1. The Office should have entered a reduction of 42 days under 37 C.F.R. § 1.704(c)(8) as a result of the IDS filed November 12, 2007;
2. The Office should have entered a reduction of 3 days under 37 C.F.R. § 1.704(c)(8) as a result of the "Notice of Related Cases" filed November 15, 2007;
3. The Office should not have entered a 366-day reduction under 37 C.F.R. § 1.704(b);
4. The Office should have entered a 153-day reduction under 37 C.F.R. § 1.704(b) as a result of Applicants' delay in responding to the Notice to File Missing Parts; and
5. The Office should have entered a 92-day reduction under 37 C.F.R. § 1.704(b) as a result of Applicants' delay in responding to the January 30, 2002 decision on petition.

Based on the facts above, the proper amount of Applicant Delay is 797 days instead of 873 days.

Since the amount of Applicant Delay is greater than the amount of A Delay, the correct patent term adjustment at the time of mailing of the notice of allowance remains 0 days.

The fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 50-0436.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and Applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to Applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Saturday
Date: 8/14/2010

PALM INTRANET

Time: 12:57:55

PTA Calculations for Application: 09/822961

Application Filing Date:	03/30/2001	PTO Delay (PTO):	707
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	873
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	76		

File Contents History

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110	11/09/2009	DOCUMENT VERIFICATION			
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100	04/01/2009	MAIL NON-FINAL REJECTION			
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98	01/28/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
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96	01/28/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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94	01/27/2009	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			

93	01/27/2009	DATE FORWARDED TO EXAMINER			
92	01/27/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)		7	84
91	01/27/2009	DISPOSAL FOR A RCE / CPA / R129			
90	01/27/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
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88	01/27/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
87	01/25/2009	DATE FORWARDED TO EXAMINER			
86	01/21/2009	AMENDMENT AFTER FINAL REJECTION			
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84	10/20/2008	MAIL FINAL REJECTION (PTOL - 326)	10		78
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73	11/15/2007	MISCELLANEOUS INCOMING LETTER			
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70	10/08/2007	DATE FORWARDED TO EXAMINER			
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63	06/21/2007	FINAL REJECTION			
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52	10/25/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
51	10/30/2006	DISPOSAL FOR A RCE / CPA / R129			
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35	07/08/2005	RESPONSE TO ELECTION / RESTRICTION FILED		143	32
34	06/02/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
33	03/19/2005	DATE FORWARDED TO EXAMINER			
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29	01/10/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
28	09/30/2004	MISCELLANEOUS INCOMING LETTER			
27.7	09/30/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	25
27	09/30/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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3	05/08/2001	CORRESPONDENCE ADDRESS CHANGE			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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